

REMARKS

Prior to entry of the present Amendment, claims 1-47 were pending in the present application. Claims 1, 12, 23 and 32 are amended above. Claims 6, 17, 25 and 34 are cancelled above. No new matter is added by the claim amendments. Entry is respectfully requested.

Claims 41-46 stand rejected under 35 U.S.C. 102(b) as being anticipated by Hart, *et al.* (WO 02/082429, hereinafter Hart '429). Claims 1-5, 7-16, 18-24, 26-40 and 47 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hart '429. Although the listing at Section 7 of the Office Action indicates that dependent claim 34 is "rejected", the Applicants note that claim 34 is indicated as being allowable at page 11, Section 8. Accordingly, claim 34 is assumed by the Applicants to be allowable. Reconsideration of the rejection and allowance of claims 1-5, 7-16, 18-24, 26-33, and 35-47 are respectfully requested.

With regard to the rejection of claims 41-46 in view of the Hart '429 reference, it is respectfully submitted that Hart '429 is not applicable as a prior art reference against the present application. With regard to the applicability of Hart '429 as a prior art reference under 35 U.S.C. 102(b), the present application was filed in the United States Patent and Trademark Office on February 5, 2004, and claims benefit under 35 U.S.C. 119(e) to United States Provisional Application 60/445,044, filed February 5, 2003. Claims 41-46 are fully supported under the first paragraph of 35 U.S.C. 112 by United States Provisional Application 60/445,044. The Hart '429 reference was published on October 17, 2002.

With the benefit of the filing date of the United States Provisional Application 60/445,044 under 35 U.S.C. 119(e), the present application has an effective filing date of February 5, 2003. Since the effective filing date of February 5, 2003 of the present application is not more than one year after the publication date of Hart '429 (October 17

2002), it follows that Hart '429 is not available as a prior art reference under 35 U.S.C. 102(b).

Accordingly, reconsideration and removal of the rejection of claims 41-46 rejected under 35 U.S.C. 102(b) as being anticipated by Hart '429, are respectfully requested.

The Applicants further note that Hart '429 is not applicable as a prior art reference under 35 U.S.C. 102(a). Hart '429 and the present application have the same inventive entity and, therefore, Hart '429 is not a publication "by others" as required by 35 U.S.C. 102(a).

The Applicants further note that Hart '429 is not applicable as a prior art reference under 35 U.S.C. 102(e). Hart '429 and the present application have the same inventive entity and, therefore, Hart '429 is not an application for patent published "by another" as required by 35 U.S.C. 102(e).

With regard to the rejections of claims 1-5, 7-16, 18-24, 26-40 and 47, the Applicants note, with appreciation, that the Office Action indicates that, at page 11, Section 8, claims 6, 17, 25 and 34 would be allowable if rewritten in independent form.

Accordingly, independent claim 1 is amended to incorporate language similar to the allowable subject matter of dependent claim 6, and claim 6 is cancelled. Independent claim 1 is further amended to recite that "the first of the plurality of operational characteristics is distortion size" and that "modifying the medium to have the first actual characteristic comprises modifying the medium to have a distortion of a size that is at or near the predefined limit of the first of the operational characteristic for distortion size".

Independent claim 12 is amended to incorporate language similar to the allowable subject matter of dependent claim 17, and claim 17 is cancelled. In addition, independent claim 12 is amended to recite that "the optical medium having the data structures being

modified in a modified region to have a distortion and to have a first actual characteristic at or near a predefined limit of a first of the plurality of operational characteristics prior to a read operation”, that “the first of the plurality of operational characteristics is distortion size” and that “the distortion is of a size that is at or near the predefined limit of the operational characteristic for distortion size”.

Independent claim 23 is amended to incorporate language similar to the allowable subject matter of dependent claim 25, and claim 25 is cancelled. Independent claim 23 is further amended to recite that “the first of the plurality of operational characteristics is distortion size” and that “modifying the medium to have the first actual characteristic comprises modifying the medium to have a distortion of a size that is at or near the predefined limit of the first of the operational characteristic for distortion size”.

Independent claim 32 is amended to incorporate language similar to the allowable subject matter of dependent claim 34, and claim 34 is cancelled. In addition, independent claim 32 is amended to recite that “the optical medium having the data structures being modified in a modified region to have a distortion and to have a first actual characteristic at or near a predefined limit of a first of the plurality of operational characteristics prior to a read operation”, that “the first of the plurality of operational characteristics is distortion size” and that “the distortion is of a size that is at or near the predefined limit of the operational characteristic for distortion size”.

It is believed that independent claims 1, 12, 23 and 32 and dependent claims 2-5, 7-11, 13-16, 18-22, 24, 26-31 and 33-40 dependent from claims 1, 12, 23 and 32, respectively, are allowable.

Accordingly, reconsideration and removal of the rejection of independent claims 1, 12, 23, 32 and 47 rejected under 35 U.S.C. 103(a) as being unpatentable over Hart ‘429, are respectfully requested. With regard to dependent claims 2-5, 7-11, 13-16, 18-22, 24, 26-31, 33-33 and 35-40, it follows that these claims should inherit the allowability of the independent claims from which they depend.

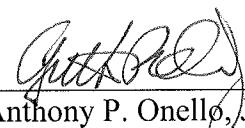
Closing Remarks

It is submitted that all claims are in condition for allowance, and such allowance is respectfully requested. If prosecution of the application can be expedited by a telephone conference, the Examiner is invited to call the undersigned at the number given below.

Authorization is hereby given to charge Deposit Account No. 501798 for any fees which may be due or to credit any overpayment.

Respectfully submitted,

Date: May 2, 2008
Mills & Onello, LLP
Eleven Beacon Street, Suite 605
Boston, MA 02108
Telephone: (617) 994-4900, Ext. 4902
Facsimile: (617) 742-7774
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Anthony P. Onello, Jr.
Registration Number 38,572
Attorney for Applicant